

REMARKS

This responds to the Final Office Action mailed on May 8, 2007 and the decision on Pre-Appeal Brief Review mailed October 4, 2007.

Claims 1, 6, 7, 8, 13, 14, 15-20, and 22-27 are amended; claim 21 is canceled; claims 28-34 are added; as a result, claims 1-20 and 22-34 are now pending in this application.

§103 Rejection of the Claims

Claims 1, 4-5, 8, 11-12, 15, 18-19, 21 and 24-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the SquareTrade website (as viewed on the WayBack Machine from May 5, 2000; hereinafter SquareTrade) in view of eBay (as viewed on the WayBack Machine from October 12, 1999 ; hereinafter eBay).

Applicants respectfully submit that the rejection of claims 1, 4-5, 8, 11-12, 15, 18-19, 21 and 24-25 under 35 U.S.C. § 103 is defective for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application.

Applicable Law

In rejecting claims under 35 U.S.C. §103, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *See* M.P.E.P. §2142.

In the recent decision of the Supreme Court on *KSR Int'l Co. v. Teleflex Inc.*¹, the analysis of obviousness previously set forth in *Graham v. John Deere Co. of Kansas City*², was reaffirmed. The Court in *Graham* set out an objective analysis for applying §103 as follows:

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.”³

¹ 127 S.Ct. 1727, 82 USPQ.2d 1385 (2007).

² 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966).

³ The Court in *KSR v. Teleflex*, at page 1730, quoted the analysis of *Graham* from page 18.

When claim elements are found in more than one prior art reference, the fact finder must determine “whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims.” *In re Kahn*⁴. In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co. of Kansas City*⁵.

Further, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*⁶. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*⁷. Office personnel must rely on the applicant’s disclosure to properly determine the meaning of the claims. *Markman v. Westview Instruments*⁸.

Applicants believe that the issue of patentability over SquareTrade in combination with eBay is best understood with regard to claim 1.

Claim 1, as amended, includes the following limitation:

determining the complaint is not resolved;

updating a record associated with the failed transaction that is not completed by the party, the updating the record includes incrementing a count of failed transactions not completed by the party.

The Final Office Action relies on Feedback Forum (eBay, page 1) in combination with SquareTrade as teaching or suggesting the above limitation.

The Feedback Forum maintains, for each user, a Feedback Profile and a Feedback Rating. The Feedback Profile includes comments about the user that have been left by other users (*Id.*). The user may receive comments about anything (Ebay, page 2). The user may receive multiple comments from a single other user (*Id.*), however, the multiple comments may only count once

⁴ 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006).

⁵ 383 U.S. 1 at 467.

⁶ 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

⁷ 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

⁸ 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (*en banc*), *aff'd*, U.S., 116 S. Ct. 1384 (1996).

for the user (Ebay, page 1). The single or multiple comments left by one user for another user may count as +1 point (positive), 0 points (neutral), or a -1 point (negative) (Id.). The point value is determined by the user who leaves the comment(s). Ebay encourages users who are treated well by a buyer or a seller to reward the buyer or seller with a positive point value (Ebay, page 1).

The Feedback Rating is a summation of the positive, neutral, and negative point values for a particular user, as described above, after an adjustment of the point values based on the a registration status of users who provided the point values (Ebay, page 4). For example, the point values provided by a user that becomes non-registered are no longer summed into the Feedback Rating (Id.). Accordingly, the Feedback Rating for a user may go up or down based on the registration status of other users who provided point values for the Feedback Rating..

Claim 1 requires updating a record associated with a failed transaction that is not completed by a party, the updating including incrementing a count of failed transactions not completed by the party. In contrast, eBay relates a Feedback Rating for a user that is a summation of point values respectively based on an evaluation of another user's treatment by the user, the summation of point values adjusted based on the present registration status of the users that provided the evaluations. Clearly such a Feedback Rating is not the same as a count of failed transactions not completed by a party, as required by claim 1. Accordingly, eBay cannot be said to teach or suggest the limitations of claim 1.

SquareTrade relates an online dispute resolution process without relating any counts. Accordingly, Square Trade cannot provide what eBay lacks.

The above remarks are also applicable to a consideration of independent claims 8, 15, and 21.

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 4-5, 11-12, 18-19 and 24-25 under 35 U.S.C. § 103 is also addressed by the above remarks.

Claims 2-3, 9-10, 16-17 and 22-23 were rejected under 35 USC § 103(a) as being unpatentable over SquareTrade in view of eBay, as applied to claims 1, 8, 15 and 21 above, and

further in view of the article UAUTOBID (“UAUTOBID.com, Inc., Introduces the Capability to Purchase Specific Vehicles Online”).

Claims 2-3 depend on independent claim 1. Claims 9-10 depend on independent claim 8. Claims 16-17 depend on independent claim 15. Claims 22-23 depend on independent claim 21. If an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 2-3, 9-10, 16-17 and 22-23 under 35 U.S.C. § 103 is also addressed by the above remarks.

Claims 6, 13, 20 and 26 were rejected under 35 USC § 103(a) as being unpatentable over SquareTrade in view of eBay as applied to claims 1, 8, 15 and 21 above, and further in view of Esposito (U.S. 6,587,838; hereinafter Esposito).

Claim 6 depends on independent claim 1. Claim 13 depends on independent claim 8. Claim 20 depends on independent claim 15. Claim 26 depends on independent claim 21. If an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 6, 13, 20 and 26 under 35 U.S.C. § 103 is also addressed by the above remarks.

In summary, SquareTrade in combination eBay in combination with UAUTOBID in combination with Esposito does not teach or suggest each and every limitation of the independent claims 1, 8, 15, and 21 as required to support rejections of the independent claims of the present application under 35 U.S.C. § 103.

In summary, Applicants believe that all rejections presented in the Final Office Action have been fully addressed and withdrawal of these rejections is respectfully requested.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4046 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

Respectfully submitted,

LOU LEONARDO ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

P.O. Box 2938

Minneapolis, MN 55402

408-278-4046

Date 11.5.2007

By Mark R. Vatuone

Mark R. Vatuone

Reg. No. 53,719

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 15 day of November 2007.

Peter Reh Feni
Name

Peter R
Signature